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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/738,543	12/17/2003	Torsten Gottschalk-Gaudig	WAS 0611 PUS / Wa 10239-S	8271
22045 7590 05/17/2010 BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			EXAMINER LIGHTFOOT, ELENA TSOY	
			ART UNIT 1715	PAPER NUMBER
			MAIL DATE 05/17/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/738,543	Applicant(s) GOTTSCHALK-GAUDIG ET AL.	
	Examiner ELENA Tsoy LIGHTFOOT	Art Unit 1715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-19 and 30-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-19 and 30-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

Amendment filed on March 23, 2010 has been entered. New claim 37 has been added. Claims 15-19 and 30-37 are pending in the application.

Claims examined on the merits are 15-19 and 30-37.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Rejection of claim 18 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement has been withdrawn due to amendment.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Rejection of claim 18 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn due to amendment.

5. Claim 15-17, 19, and 30-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites in line 8 and last three lines: "**at least one** of I) and II)...; and I and II being used alone or in any desired mixtures", which renders the claim indefinite

Art Unit: 1715

because it is not clear how “I and II” can be used **alone**”. For examining purposes the phrase was interpreted as “at least one of I) and II)...; ~~and I and II being used alone or in any desired mixtures~~”.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Rejection of claims 15-17, 19, and 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo et al (JP 04298538 A) has been withdrawn due to amendment.

8. Claims 15-19 and 30-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo et al (JP 04298538 A) in view of Fitzgerald et al (US 5623028) and Ward et al (US 5573189).

Endo et al is applied here for the same reasons as set forth in paragraph 10 of the Office Action mailed on 1/7/2010.

Endo et al further teaches that blocking 30-70% of silanol groups on the surface of silica filler by silane coupling agent, the silica before treatment having the number of silanol groups on the surface of silica filler in the range of 1-30 groups/nm², preferably 5-15 groups/nm² (See Transl. P15), particle size of 0.1-5 microns (See Transl. P16) and

Art Unit: 1715

BET surface of 100-700 m²/g (See Transl. P12), provides excellent dispersibility in a polyester film composition (See Transl. Example 1).

Endo et al fails to teach that *fumed silica* is suitable for the use as silica filler having the number of silanol groups within the range of 1-30 groups/nm².

Fitzgerald et al teaches that a raw *fumed silica* having a BET surface area of 200 m²/g and a surface silanol density of 4.5 OH groups/nm that may be treated with silane to reduce the concentration of surface silanol groups, is suitable for the use as filler in resin compositions (See column 11, lines 52-55) to impart desired properties to cured compositions (See column 1, lines 57-68). Note that "nm" in Fitzgerald et al means square nm (See column 15, line 30). **Ward et al** teaches that a typical commercially available *fumed silica* filler has a surface area of 200 m²/g (See column 6, lines 3-4) and particle size of 0.20-0.35 microns (See column 2, lines 29-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used typical commercially available raw *fumed silica* having particle size of 0.20-0.35 microns as raw silica in Endo et al for treating with silane coupling agent with the expectation of producing silica having excellent dispersibility in a polyester film composition since Endo et al does not limit its teaching to particular raw silica, and commercially available raw *fumed silica* has particle size, a surface area and a surface silanol density within ranges required in raw silica of Endo et al.

As to claim 37, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for

patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Response to Arguments

9. Applicant's arguments with respect to claims 15-19 and 30-37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELENA Tsoy LIGHTFOOT whose telephone number is

Art Unit: 1715

(571)272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy Lightfoot, Ph.D.
Primary Examiner
Art Unit 1715

May 14, 2010

/Elena Tsoy Lightfoot/